UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,897	08/04/2003	Florence Tournilhac	05725.1234-00	7929

22852 7590 10/19/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
MERCIER, MELISSA S	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,897	TOURNILHAC, FLORENCE	
	Examiner	Art Unit	
	Melissa S. Mercier	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-102* is/are pending in the application.

4a) Of the above claim(s) *13-18,26,29,32 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,19-25,27,28,30,31,33-38 and 40-88* is/are rejected.

7)☒ Claim(s) *54* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8-4-03,3-4-05,7-27-06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on July 27, 2006 is acknowledged. The traversal is on the ground(s) that searching all claims is not a search burden on the examiner. This is not found persuasive because Group I is drawn to a composition, while Group II is drawn to a method of use. The examiner would be required to perform separate searches, using different search terms in order to search both groups. Applicant is reminded of Rejoinder if the product/composition claims are found to be allowable.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election of (A) the species of formula (1) wherein R_1 is R-CO-, R_2 is R-CO-, and R_3 is H; (B) C_4 to C_{22} fatty acid ester oils; and (C) a lipstick, in the reply filed on July 27, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-102 are pending in this application. Claims 89-102 are withdrawn form consideration as directed toward a non-elected group. Claims 13-18, 26, 29, 32, and 39 are withdrawn as reading on a non-elected structure. Claims 1-12, 19-25, 27-28, 30-31, 33-38, 40-88 are rejected.

Applicant is reminded that it is applicant's duty to disclose which claims read on the elected species.

Priority

Applicants claim to priority to 60/402,070, 60/402,072, and 60/402,073 is acknowledged.

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/402,073, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Applicant has not provided adequate written description for Structure III as claimed in Claim 19 of the instant application. Therefore, the priority date for Claims 19-24, 27, 30, and 33 is 08/04/2003, the effective filing date of the instant application.

Information Disclosure Statement

Receipt of the Information Disclosure Statements received on August 4, 2003, March 4, 2005, and July 27, 2006 is acknowledged.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states,

"the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claim 54 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on a later claim. See MPEP § 608.01(n). Accordingly, the claim 54 not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 8-10, 20-22, 25, 27-28, 30-31, 33, and 77 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, it is unclear to the examiner what applicant is claiming with the limitation "a sufficient amount". Sufficient is a relative term, the specification does not define the term, and the applicant has not provided a means of determining the scope of the limitation.

Regarding Claim 4, it is unclear to the examiner which "the at least one fatty acid ester of dextrin" applicant is referring to. Claim 4 is dependent on claim 3, which

contains two fatty acid esters of dextrin. Clarification is requested. The examiner is interpreting this claim to mean the fatty acid ester of dextrin with a degree of substitution of less than 2 has a glucose-repeating unit.

Regarding Claims 8-10, 20-22, 25, 27-28, 30-31 and 33, it is unclear to the examiner is applicant is referring to R_1, R_2, R_3, when citing the limitation R. Clarification is requested. The examiner is interpreting the limitation to be any of the R radicals.

Regarding Claim 25 and 27, it is unclear to the examiner what applicant is claiming by the limitation "wherein the R-CO- of formula (I) is chosen from at least one of". It is unclear to the examiner how R-CO- could have more than one radical.

Claim 77 recites the limitation "non-waxy gelling or thickening system" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 1, from which Claim 7 depends does not contain a non-waxy gelling or thickening system".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7-12, 19-25, 27-28, 30-31, 33-36, 40-49, 60-61,67-76, 79, 82-88 rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US Patent 5,840,883).

Suzuki discloses a composition comprising a fatty acid ester of dextrin and a lubricant. "The substitution degree of fatty acids to dextrin is 1.0 to 3.0 per glucose unit, and preferably 1.2 to 2.8 per glucose unit" (column 5, lines 19-21). The lubricants can include "2-hexyldeconol, oleyl alcohol, isostearyl alcohol, and caster oil" (column 6, lines 7-39). These lubricants meet the solubility parameters claimed in Claims 1 and 19.

Regarding Claims 2, Suzuki discloses the degree of substitution is per glucose unit.

Regarding Claims 7-12, 19-24, 28, and 30 Suzuki teaches, "dextrin used in the present invention has an average saccharide polymerization degree of 3 to 150, preferably 10 to 100. The saccharide chains may be straight or branched. The straight chain fatty acids used are saturated fatty acids having 8 to 22 carbon atoms. The branched fatty acids used are saturated fatty acids having 4 to 26 carbon atoms. The unsaturated fatty acids used have 6 to 30 carbon atoms. The straight chain saturated fatty acids each having 6 or less carbon atoms" (column 3, lines 39-67, column 4, lines 1-39).

Regarding Claim 25, 27, 31, and 33 Suzuki teaches examples of straight chain fatty acids including "caprylic acid, capric acid, lauric acid, myristic acid, palmitic acid, stearic acid" (column 3, lines 50-53). The branched fatty acids include "2-ethylbutyric acid, ethylmethylacetic acid, isoheptanoic acid, 2-ethylhexanoic acid, isononoic acid, isodecanoic acid, for example" (column 3, lines 60-67).

Regarding Claims 34-36 and 42-43, Suzuki teaches the preferred substitution degree of fatty acids to dextrin in 1.0 to 3.0 per glucose unit as described above. It is the

examiners position that this would include all substitutions of less than 2 down to 1.0 and from 2 to 3.0. Which would encompass the claimed ranges in the instant claims.

Regarding Claims 40-41, Suzuki discloses numerous examples of fatty acid esters of dextrin. The PTO does not have laboratory facilities in order to experimentally determine the MW of each ester, therefore the burden shifts to applicant to show the fatty acid esters of dextrin disclosed by Suzuki fall outside of the molecular weight range claimed in the instant claims.

Regarding Claims 44-49, Suzuki discloses "when the dextrin ester of fatty acids is compounded into the composition, the amount of the fatty acids compounded is preferably 0.1 to 90% by weight, and more preferably 0.5 to 50%, though there is no particular restriction on the amount" (column 6, lines 1-6).

Regarding Claims 60-61 and 74-76, as stated above, Suzuki discloses the use of castor oil which meets the solubility criteria of the instant claims, according to applicants table 1, in the instant application.

Regarding Claims 67-73, Suzuki's examples 1 and 2, discloses an oil-in-water-emulsion comprising 4.0% of liquid paraffin with 5.0% 1,3 butylene glycol; and a water in oil emulsion comprising 10.0% 1,3-butylene glycol, respectively. (column 8, line 38 and column 9, line 8). Additionally, Suzuki's example 4 comprises 30.0% octyldodecyl lanolate (column 9, line 57).

Regarding Claim 79, Suzuki discloses, "additional additives may be added to the compositions, such as dyes and pigments" (column 6, lines 39-49).

Regarding Claims 82-86, Suzuki's example 4 teaches a lipstick composition. Suzuki additionally teaches the mixture was poured into a container. This would inherently include a stick, since lipstick is generally found to be in the form of stick.

Regarding Claim 87 and 88, Suzuki's example 3 teaches a foundation which is free of waxes and water.

Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (US Patent 5,106,625).

Yamamoto discloses a composition for external use consisting essentially of a dextrin fatty acid ester, a glycerol fatty acid ester, and oil.

Yamamoto discloses, "the dextrin fatty acid esters used in this invention are of oil-soluble and preferably those ester compounds of (1) a fatty acid having 8-24 carbon atoms, more preferably 14-18 carbon atoms, and (2) a dextrin of an average polymerization degree of 10 to 50, more preferably those of 20-30. A preferable substitution degree of fatty acids is not less than 1.0 per one glucose unit. Examples of these dextrin fatty acid esters are dextrin palmitate, dextrin stearate, dextrin palmitate stearate, dextrin oleate, dextrin isopalmitate, dextrin isostearate, and the like. They can be used singly or as a mixture of one or more of them" (column 2, lines 28-39).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-4, 50-53, and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US Patent 5,840,883) in view of Yamamota et al. (US Patent 5,106,625).

Suzuki's teachings are described above and applied in the same manner.

Suzuki does not teach the use of 2 fatty acid esters of dextrin, one with a degree of substitution less than 2, and one with a degree of substitution greater than 2.

Yamamoto's teaching are discussed above and applied in the same manner.

Regarding claims 50-53, Yamamoto further discloses, "the total amount of fatty acids to be incorporated into the composition is preferably between 5-50%" (column 2, lines 64-67).

Regarding Claims 55-59, Yamamoto does not disclose the weight ratios to be employed when utilizing a combination of the dextrin esters of fatty acids, however, it would be within the knowledge of one of ordinary skill in this art to admix the esters in ratios that would give the desired consistency and effect. One of ordinary skill in this art could accomplish this through routine experimentation.

If would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used 2 fatty acid esters of dextrin, one with a degree of substitution greater than 2 and one with a degree of substitution less than 2 in order to obtain a cosmetic composition which exhibits "excellent retentivity, and extendability on the skin and adhesive capabilities to the skin" (Yamamoto, column 1, lines 10-13).

Claims 1, 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US Patent 5,840,883) in view of Derwent Publication XP002240607.

The teachings of Suzuki are discussed above and applied in the same manner.

Suzuki teaches the use of a volatile organic oil.

The Derwent Publication teaches an "oil based make up composition comprising 30-90% weight of octamethylcyclotetrasiloxane and/or decamethylcyclopentasiloxane" (abstract).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have substituted or added the volatile organic oil into the composition taught by Suzuki, in order to make a composition, which has excellent stability and fluidity.

Claims 1 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US Patent 5,840,883) in view of Bhatia et al. (US Patent 6,410,003).

Suzuki's teaching as they apply to claim 1 is discussed above and applied in the same manner.

Suzuki does not teach the addition of: N-lauryl L-glutamate-di-N-butylamide, monodibenzylidene sorbitol, 1,2- and 1,3-cyclohexane derivatives bearing at least one amide functional group, or palmitates of dextrin and of fatty acid with a degree of substitution of greater than 2 relative to one glucose unit.

Bhatia discloses the preparation of a 1, 2- and 1,3-cyclohexane derivative to be used as a thickener in a cosmetic composition (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the cyclohexane derivative taught by Bhatia, since Bhatia discloses the compound provides structure, yet at the same time gives the composition a deposit with a low visibility residue" (column 2, lines 54-60). .

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of cosmetic compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Claims 3 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US Patent 5,840,883) in view of Yamamota et al. (US Patent 5,106,625) and further in view of Bhatia et al. (US Patent 6,410,003).

Suzuki's and Yamamoto's teachings as they apply to claim 3 are discussed above and applied in the same manner.

Neither Suzuki nor Yamamoto teaches the addition of: N-lauryl L-glutamate-di-N-butylamide, monodibenzylidene sorbitol, and 1,2- and 1,3-cyclohexane derivatives bearing at least one amide functional group.

Bhatia discloses the preparation of a 1, 2- and 1,3-cyclohexane derivative to be used as a thickener in a cosmetic composition (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the cyclohexane derivative taught by Bhatia, since Bhatia discloses the compound provides structure, yet at the same time gives the composition a deposit with a low visibility residue" (column 2, lines 54-60). .

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of cosmetic compositions. It therefore follows that the instant claims define prime facie

obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Claims 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US Patent 5,840,883).

Suzuki's teaching are described above and applied in the same manner.

Suzuki does not teach specific amounts of dyes that are used in the examples. Suzuki teaches a "suitable amount" is to be added.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have expanded on or modified Suzuki's teachings of a suitable amount in order to obtain the results and color intensity desired. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See also Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSMercier

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600